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Paper No. 5

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SEP 03 2002

OFFICE OF PETITIONS

In re Application of

Britt et al.

Application No. 09/932,532

Filed: August 17, 2001

Attorney Docket No. 33053

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ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed June 13, 2002, to revive the above-identified application. This is also a decision on the petition under 37 CFR 1.47(a), filed June 13, 2002.

The petition under 37 CFR 1.137(b) is **granted**.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The petition under 37 CFR 1.137

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed September 19, 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 20, 2001.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b) and the application is hereby revived.

The petition under 37 CFR 1.47

The above-identified application was filed on August 17, 2001, with a declaration signed by only one of the two inventors. Accordingly, on September 19, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring a declaration signed by all the inventors (or a petition under 37 CFR 1.47) and a surcharge for its late filing. The surcharge of \$130 will be charged to petitioner's deposit account.

A grantable petition under 37 CFR 1.47(a) requires

- (1) proof that the non-signing inventor cannot be found or reached after diligent effort or that the inventor refuses to sign after having been presented with the application papers (specification, claims, and drawings),

- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

The instant petition fails to satisfy (1).

As to item (1), petitioner must establish that the non-signing inventor refused to sign the oath or declaration after being presented with the application papers. Petitioner has failed to establish that the non-signing inventor was presented with a copy of the application. An inventor cannot sign a declaration stating he or she has "reviewed and understands the application papers" when the inventor has not been presented with a copy of the application and therefore has not reviewed the application. Refusal within the meaning of 37 CFR 1.47 requires that the inventor be presented¹ with the application papers and given adequate time to review the contents of the application. Until the inventor reviews the papers and reads the specification and claims, he cannot know if he is actually an inventor of the claimed invention. Petitioner should send a copy of the application to the inventor along with instructions setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as a certified mail return receipt, cover letter of instructions, telegram, etc.

Petitioner should note that when there is an express oral refusal, if the non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47 by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

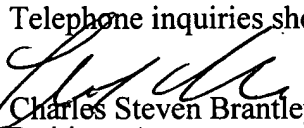
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.


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Office of the Deputy Commissioner
for Patent Examination Policy

¹ It is not sufficient for an applicant to simply make the papers available. See MPEP, Section 409.03(d).